

REMARKS

Please consider the foregoing claims and the following remarks in response to the Office communication mailed on May 4, 2009.

The present invention has to do with an electrically conductive floor covering having a transparent top coating comprising a polymer and particles with a conductive coating. The top coating does not increase the electrical resistance of the flooring significantly and it significantly improves flooring cleaning properties.

Claims 12-13, 15-18 and 23-26 are rejected as being unpatentable over U.S. Patent No. 5,516,546 (Hari et al.) in view of published U.S. Patent Application No. 2003/0113566 A1 (Clemens) and further in view of U.S. Patent No. 5,626,948 (Ferber) under 35 U.S.C. §103(a).

Hari does not disclose or suggest a transparent top coating. Hari does not disclose or suggest incorporating substantially spherical glass particles in a top coating. And Hari does not disclose or suggest coating such particles with a conductive coating comprised of silver, aluminum, copper, nickel, gold, or an alloy thereof with another metal. Hari employs amorphous or spheroidal graphite and/or carbon fibers and/or finely divided metal. None of these materials are employed as particles in applicants' pending claims. Hari is not concerned about making a transparent top coating, a very important feature of applicants' invention because it significantly improves flooring cleaning properties without significantly increasing the electrical resistance of the flooring and it allows the decorative substrate beneath the top coating to show through. Hari's invention is concerned only with conductivity and as such he uses conductive materials that are not employed by applicants because they cannot be used in a

transparent topcoating. There is no disclosure in Hari that would teach or suggest to one skilled in the art that metal coated glass beads could be used to make a transparent conductive top coating for a conductive or antistatic flooring substrate.

Clemens has to do with a coating system that is field applied or shop applied over wood or concrete. The topcoat of Clemens is applied as a powder and flame sprayed. Clemens employs a topcoat thermoplastic composition that is pigmented and can contain fillers. (See ¶¶ [0020] – [0029].) The Clemens topcoat is not transparent. In fact, the topcoat of Clemens provides the decoration to his coating system as opposed to applicants' claimed surface covering wherein the transparent topcoat allows the underlying decorative elements to show through. This fact is reinforced by the disclosure at paragraphs [0013], [0014] and [0018] describing the use of the topcoat composition as a stand alone coating. Paragraph [0018] reads as follows: "All coatings can be made available in virtually an unlimited array of color selections and finishes. From fluorescent to jet-black; from smooth-high gloss, dimple and pinhole free surface- to wrinkled textures; as well as colors and finishes between these extremes." The requirement of pigments and optional fillers by Clemens teaches away from applicants' claimed invention because a colored and decorative topcoat has a decorative purpose whereas a transparent topcoat as claimed by applicants allows decoration to show through. Thus, the combination of Clemens with Hari cannot support the Section 103 rejection and it must be withdrawn.

Ferber describes a top composition layer comprising a substantial amount of pigment in order to mask the bottom composition layer and impart desired color to the Ferber system. According to Ferber, "A need has arisen for colored conductive

compositions which are available in a wide variety of colors to be used as part of an electrical system on the surface of substrates." (See Ferber, col. 2, ln. 14-16.) Ferber goes on to say.

"The prior art has also failed to provide a conductive composition for use as part of an electrical system which is vertically conductive, as defined herein, and which comprises multiple layers wherein the top layer masks one or more lower layers. The present invention addresses the aforementioned shortcomings and needs of the prior art." (See Ferber, col. 2, ln. 22-27.)

Ferber's top composition layer is not transparent and it cannot support the rejection.

The combination of Hari with Clemens and Ferber cannot render applicants' claims obvious because Hari's coating uses different conductive materials from applicants' and his coating is not transparent. Clemens and Ferber both require pigmented coatings that mask the lower layer and provide decoration. Their coatings are not transparent. The combination cannot make or render obvious applicants' claimed invention. Withdrawal of the rejection of claims 12, 15-18 and 23-26 under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and further in view of Ferber is respectfully requested.

Regarding claim 15, Kojimoto has been cited as teaching a silver glass bead. But Kojimoto requires a two component blend to make his electrically-conductive floor. One component comprises an electrically-conductive material of small short fibers and the other component comprises an electrically conductive filler comprised of a powdered or scaly electrically conductive material, including silver glass beads. Kojimoto's filler is employed in a range of from 10% to 50% but this amount is in

addition to the conductive fibers. Thus, the total conductive material used by Kojimoto is greater than 10% and does not overlap with applicants' claimed range. Furthermore, Kojimoto teaches that a "large amount of electrically-conductive material" is necessary to make his invention effective and this teaches away from applicants' invention which requires a small amount, between 0.01 and 10% by weight of the top coating. (See Kojimoto translation, p.3, ln. 6-20.)

Kojimoto cannot support a rejection of claim 15. Furthermore, claim 15 depends from allowable claim 12 and, as such, must be allowed.

As to the rejections of claims 16, 17 and 23, 18 and 24 and 20, all of these are dependent from allowable claims and their allowance is accordingly required.

Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and Ferber as applied above and further in view of either U.S. Patent No. 5,120,811 (Glotfelter) or published U.S. Patent Application No. 2005/0227104 A1 (Kim). Claim 19 depends from claim 16 and provides for a top coating thickness of between 0.5 μm and 100 μm . All of the limitations of dependent claim 16 and independent claim 12 from which claim 16 depends are incorporated in claim 19. Claim 19 accordingly depends from claims which are patentably distinct from the primary references, Hari, Clemens and Ferber, as discussed above. The disclosures of coating thicknesses provided by Glotfelter or Kim are not sufficient to overcome the deficiencies of Hari, Clemens and Ferber. Withdrawal of the 35 U.S.C. §103(a) rejection of claim 19 is therefore respectfully requested.

Claims 21 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and Ferber as applied above and further in view of U.S.

Patent No. 4,101,689 (Wienand et al.). Wienand is applied as teaching an antistatic or electrically conductive floor covering having a conductive top layer of a few tenths of a millimeter and for teaching a substrate of polyvinyl chloride resin (PVC) having vertical holes filled with conductive paste to produce vertical conductive channels. But the construction disclosed by Wienand is completely different from the construction claimed by applicants. Wienand fills holes in a substrate with a conductive paste and then coats one side of the substrate with the conductive paste. Alternatively, Weinand coats both sides of a substrate with conductive paste and then cuts the substrate along a plane parallel to the upper and lower surfaces. (See Fig. 5, line A-A and specification at col. 3., ln. 22-35.) In all embodiments of Weinand, the coated surface of the substrate is on the underside. The coated surface is not a top coating. Applicants employ glass spheres coated with a conductive layer and mix them with a dispersion of a topcoat material. Then this mixture is coated onto a substrate as a top coating. There is nothing about Wienand that would make applicants' product obvious because Weinand's construction is completely different from applicants' construction. Furthermore, the primary references in this rejection, Hari, Clemens and Ferber, have been distinguished above in respect of claim 12 from which claim 21 depends. Claim 26 is an independent claim but it incorporates all of the elements of claim 12 which have been distinguished from Hari, Clemens and Ferber. Accordingly, claims 21 and 26 are allowable and withdrawal of the §103 rejection over Hari in view of Clemens and Ferber and further in view of Wienand is respectfully requested.

Conclusion

The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 12, 15-19, 21 and 23-26 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions, and/or additional amendment would help advance the prosecution of the instant application.

If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge any required petition fee to Deposit Account No. 14-1263.

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By



William R. Robinson
Attorney for Applicants
Reg. No. 27,224
721 Route 202-206
P.O. Box 5933
Bridgewater, NJ 08807-5933
Phone: (908) 722-0700
Fax: (908) 722-0755

July 29, 2009